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In re Patent Application of :)
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For: NETWORK BASED LOAN APPROVAL AND DOCUMENT ORIGINATION
SYSTEM

Mail Stop Appeal Brief - Patents
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REPLY BRIEF

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I. STATUS OF CLAIMS

A. Total Number of Claims Pending in Application

There are 18 claims pending in the application.

B. Current Status of claims

1. Claims canceled: 2,8
2. Claims withdrawn: none
3. Claims pending: 1, 3-7 and 9-20
4. Claims rejected: 1, 3-7 and 9-20
5. Claims objected to: none
6. Claims allowed: none

C. Claims on appeal

Claims 1, 3-7 and 9-20 are on appeal.

II. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention, as set forth in claim 1, and as described in the specification of the above-identified patent application, is directed to a system for producing and sending a loan document to a customer. The system may comprise: a web-enabled customer interface (158) which receives loan information (89) from the customer (88); multiple branch terminals (108; 110) configured for receiving the loan information (89) at branch locations (104); a network (94) coupled to the customer interface (158) and the branch terminals (108; 110), the network (94) receiving the loan information (89) from at least one of the customer interface (158) and the branch terminals (108; 110); a web site (96) coupled to the network (94), the web site (96) prompting the customer (88) to enter the loan information (89), receiving the loan information (89), and merging the loan information (89) with a loan application form (Specification, Page 6, lines 6-8) to produce a loan application (116); a loan processor computing system (90) hosting the web site (96) and storing the loan application form (Specification, Page 6, lines 6-8), the loan processor computing system (90) receiving the loan application (116) and automatically performing a credit check on the customer (88) based on the loan application (116), wherein the loan processor computing system (90) performs the credit check by sending the loan application (116) to a credit approval agency (118), the loan processor computing system (90) determining whether the loan application (116) is approved (120); a loan forms database (114) storing forms used in the creation of loan documents (124); and a loan document creation server (122) coupled to the loan processor computing system (90) and the loan forms database (114), wherein the loan processor computing system (90), upon approving the loan application (116), automatically forwards the loan application (116) to the loan document creation server (122), the loan document creation server (122) accessing the loan forms database (114) and automatically generating and sending the loan document (124) to the customer (88), based on the loan

application (116) and the accessed loan forms in the loan forms database (114), the loan document creation server (122) sending the loan document (124) to the customer (88) through one of email (126), facsimile (128), the network (94), and a printer (132) coupled to a network (94). *See* present application, specification, page 5, line 23 through page 12, line 20 and Figs. 2 and 3.

The present invention, as set forth in claim 6, and as described in the specification of the above-identified patent application, is directed to a method for producing and sending a loan document (124) to a customer (88), the loan document (124) detailing terms of a loan. The method may comprise the steps of: receiving loan information (89) from the customer (88) over a network (94) at a web site (96) hosted by a loan approval system computer (98), the web site (96) configured to receive information over the network (94) from at least one of multiple bank branches (104) and from a customer interface (158), the loan approval system computer (98) storing a loan application form (Specification, Page 6, lines 6-8); merging, at the loan approval system computer (98), the loan information (89) with the loan application form (Specification, Page 6, lines 6-8) to produce a loan application (116); forwarding the loan application (116) to a credit approval agency (118) and receiving a loan decision indicator (120) at the loan processor computing system (90) from the credit approval agency (118); determining, at the loan approval system computer (98), whether the customer (88) should receive the loan based on the loan decision indicator (120) received from the credit approval agency (118); when the processing determines that the customer (88) should receive the loan, automatically forwarding the approved loan application (116) to a loan document creation server (122); accessing a loan forms database (114) from the loan document creation server (122); automatically generating the loan document (124) through the loan document creation server (122) in response to the approved

loan application (116), the generated loan document (124) based on a form (Specification, Page 6, lines 6-8) stored in the loan forms database (114) and the approved loan application (116); and sending the customer (88) the generated loan document (124) associated with the loan and based on the loan application (116), wherein the document (124) is created at the loan document creation server (122) at the request of the loan approval system computer (98), the sending being through one of e-mail (126), facsimile (128), the network (94), and a printer (132) coupled to a network (94). *See* present application, specification, page 5, line 23 through page 12, line 20; Figs. 2 and 3.

The present invention, as set forth in claim 7, and as described in the specification of the above-identified patent application, is directed to a method for creating a loan contract (Specification, Page 8, lines 13-15) between a customer (88) and a bank (91), the loan contract (Specification, Page 8, lines 13-15) including terms where the bank (91) loans money to the customer (88), and terms where the customer (88) is obligated to pay the money back to the bank (91). The method may comprise: the bank performing the steps of receiving loan information (89) from the customer (88) at a web site (96) hosted by a loan approval system computer (98), the web site (96) configured to receive information over the network (94) from at least one of multiple bank branches (104) and from a customer interface (158), the loan information (89) indicating the terms; analyzing the received loan information (89) for completeness and prompting the customer (88) if the received loan information (89) is incomplete; merging, at the loan approval system computer (98), the loan information (89) with a loan application form (Specification, Page 6, lines 6-8) located at the loan approval system computer (98), to produce a loan application (116); processing the loan application (116) at the loan approval system computer (98) to determine whether the bank (91) desires to enter into the loan contract

(Specification, Page 8, lines 13-15), the processing including automatically forwarding the loan application (116) to a credit approval agency (118), receiving a loan decision indicator (120) from the credit approval agency (118); and deciding to enter into a loan contract (Specification, Page 8, lines 13-15) based on the loan decision indicator (120) received through the loan approval system computer (98): automatically forwarding the loan application (116) from the loan approval system computer (98) to a loan document creation server (122), accessing a loan forms database (114) from the loan document creation server (122), generating a loan document (124) at the loan document creation server (122) based on the loan application (116) and a form (Specification, Page 6, lines 6-8) stored in the loan forms database (114), and sending the loan document (124) to the customer (88), the loan document (124) being based on the loan application (116) and associated with the loan contract (Specification, Page 8, lines 13-15) and listing the terms of the loan; and sending a check (136) to the customer (88), the check (136) corresponding to the loan contract (Specification, Page 8, lines 13-15); wherein cashing of the check (136) indicates acceptance by the customer (88) of the terms listed in the loan document (124). *See* present application, specification, page 5, line 23 through page 12, line 20; Figs. 2 and 3.

III. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues to be reviewed by the Board are (1) whether, under 35 U.S.C. § 103(a), claims 1, 3-6, 14-15 and 17-20 are unpatentable over U.S. Patent No. 7,395,239 to Riseman (hereinafter “Riseman”) in view of U.S. Patent No. 6,385,594 to Lebda et al. (hereinafter “Lebda”) and in view of U.S. Patent No. 5,870,721 to Norris (hereinafter “Norris”); and (2) whether, under 35 U.S.C. § 103(a), claims 7, 9-13 and 16 are unpatentable over Riseman, Lebda, Norris and in further view of of U.S. Patent No. 5,740,035 to Cohen et al. (hereinafter “Cohen”).

IV. ARGUMENT

A. Summary of Argument

Appellants respectfully submit that the rejection of claims 1, 3-7, and 9-20 under 35 U.S.C. § 103(a) is improper. Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Patent Office can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of references. *Id.* As stated in MPEP § 2143.03, in order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Since the cited references fail to teach or suggest all the limitations in any of the appealed claims 1, 3-7, and 9-20, Appellants respectfully submit that the Examiner has not met the burden of proof in establishing obviousness of the claimed invention.

B. Overview of the Present Invention and the Cited References

Before discussing the pending claims, a brief summary of a preferred embodiment of Appellants' invention is provided in order to highlight some of its advantageous characteristics. An overview of the Riseman, Lebda, Norris and Cohen references is also provided.

The present invention relates to a *network based loan approval and document origination system* wherein a customer sends loan information through the Internet to a loan approval system mainframe of a bank. The loan information, which may be either entered into a blank loan form displayed on a web site hosted by the loan approval system computer, or via multiple branch terminals which are configured to receive loan information at branch locations, is transmitted over a network. *See*, Specification, Page 6, lines 4-8; Page 6, line 24 — Page 7, line 7. A web site coupled to the network then prompts the customer to enter information, receives information,

and is operable to merge the customer's loan information with a loan application form. This combination results in a completed loan application which is quickly and automatically generated. *See*, Specification, Page 7, lines 13-21.

The application may then be received by a loan processor computing system, which hosts the web site and which also stores loan application form(s), and which may also automatically perform a credit check on the customer based on the loan application. In performing the credit check, the loan processor computing system may forward the loan application to a credit approval agency. Based on the results from the credit approval agency, or other loan decision indicator, the loan processor computing system will determine whether the loan application has been approved, and accordingly, whether the customer should receive the loan. *See*, Specification, Page 7, line 22 — Page 8, line 6.

If the customer is approved, the loan processor computing system automatically forwards the loan application to the loan document creation server, which is coupled to both the loan processor computing system and a loans forms database which stores forms used in the creation of loan documents. The loan document creation server can then access the loan forms database to generate and send the loan document(s) to the customer, by e-mail, facsimile, over the network, or via a printer coupled to the network. The loan documents may include, without limitation, a loan contract, credit insurance information, and approval letter, promissory note, attachments, and the terms of the loan contract. *See*, Specification, Page 8, lines 7-21. In some circumstances, a check associated with the loan documents may be sent directly to the customer. *See*, Specification, Page 9, lines 2-10. The customer's cashing of the check would then indicate acceptance by the customer of the terms listed in the loan document.

Prior art loan origination systems required time for branch employees to produce loan applications, time for back office employees to review applications and enter the loan information into a loan approval system mainframe, and time for loan documents to be sent by mail to the customer. *See* Specification, Page 9, line 25— Page 10, line 4. The present invention improves on the systems of the prior art by automating many of the required steps and can operate to streamline the acceptance of the loan by the customer.

Riseman, by contrast, is directed to Mortgage System Software (“MSS”) 106 which unilaterally evaluates the manually entered information and performs all of the processing steps, thereby eliminating the need for a loan application for forwarding. For example, the MSS automatically accesses and reviews data regarding the applicant’s credit history. *See* Riseman, Column 5, lines 31-35. Further, in step 206, the MSS applies underwriting rules and in step 208, the MSS determines whether to approve the loan. In Riseman, therefore, it appears that the information itself, as entered by the user, comprises the “loan application[.]” *Id.* at lines 41-65. Moreover, no loan documentation is originated in the system described in Riseman.

Lebda is directed toward a method for providing a universal electronic credit qualification form on, for example, the Internet, and allowing a user to use this form to apply for credit from variety of lending institutions. After receiving credit data from a web site, a special loan processing computer applies a filter to the data. The filter comprises loan selection criteria provided by lending institutions which allows these institutions to filter out loan applications that they do not want. In the system described by Lebda, once the data is filtered, it is transmitted to a plurality of lending institutions, allowing borrowers and lenders with compatible objectives to be matched via the Internet. *See* Lebda, Column 1, lines 48-65. Although Lebda does relate to performing a credit check on an Internet user, the purpose of Lebda (allowing a customer to

apply for credit at numerous lending institutions) is inconsistent with the goals of the present invention (performing a credit check before accepting a loan applicant's application for credit at a single lending institution).

Norris, which relates generally to closed loop financial transactions, is also inapposite. More specifically, Norris describes a "real time" method and apparatus for processing loans automatically, beginning with the loan application and continuing through to transfer of funds to the borrower and to arranging for repayment. The loan approval system described in Norris is intended to provide a faster, more convenient method of obtaining "...smaller loans, those above credit-card limits but still below a level where there might be a significant concern of the ability of the lender to repay the loan[.]" *See* Norris, Column 1, lines 60-62. Norris only teaches a very minimal requirement with regards to an applicant's information disclosure. And although this approach accords with the purpose and teachings of Norris, it is for this very reason that Norris fails to teach or disclose many of the elements in the present invention.

Finally, Cohen (which describes and claims a self administered survey device) has nothing to do with a loan approval and document origination system, or even with loan systems generally. Cohen, rather, is directed toward "[s]elf-administered survey devices includ[ing] a display, an input device, a memory and a control device which controls the display to show at least one survey question and control the memory to store a response to the at least one question." *See* Cohen, Abstract.

C. Independent Claim 1 is Patentable over Riseman, Lebda and Norris

Appellants submit that the combination of Riseman, Lebda and Norris does not disclose each and every element of claim 1.

1. Riseman, Lebda and Norris, Taken Alone or in Combination, do not Teach or Suggest “Merging the Loan Information with a Loan Application Form to Produce a Loan Application.”

Riseman, Lebda and Norris fail to teach or suggest merging the loan information with a loan application form to produce a loan application, as recited in claim 1.

The Examiner contends that Riseman teaches “a web site coupled to the network, the web site prompting the customer to enter the loan information, receiving the loan information, and *merging the loan information with a loan application form to produce a loan application* (col. 4, lines 37 through col.5, line 17, fig.1)[.]” Examiner’s Answer at Page 5 (emphasis added). The sections of Riseman cited by the Examiner describe, at most, an applicant being prompted “to enter information regarding the applicant in step 202 by the display of the screen illustrated in Fig. 3B[.]” Riseman, Column 5, lines 7-8. However, in the claimed invention, a loan application is created from the combination of the loan information and the loan application form, so that the loan application may subsequently be forwarded both to a credit agency and to a document server for creation of loan documents. Significantly, the Examiner has not cited any portion of Riseman that shows loan information being *merged* with a loan application form to produce a loan application. No document server is taught by Riseman, and furthermore, the computer running the Mortgage System Software (MSS) 106 in Riseman unilaterally evaluates the entered information and performs all of the processing steps, thereby eliminating the need for a loan application for forwarding. For example, as set forth in Column 5, lines 31-35, in step 204, the MSS automatically accesses and reviews data regarding the applicant’s credit history. Further, in step 206, the MSS applies underwriting rules and in step 208, the MSS determines whether to approve the loan. In Riseman, therefore, it appears that the information itself, as entered by the user, constitutes the “loan application[.]” and thus, Riseman would not teach or suggest merging loan information with a loan application form to produce the loan application.

The Examiner further argues that, in *Riseman*, “the loan information is the information provided by the applicant, the loan application form is the web form the [sic] is accessed via the lender’s web site, and the loan application is the completed loan form after the applicant enters data and is stored in a database (electronic loan application) (col. 5, lines 23-25).” Office Action of Apr. 11, 2011, Page 8; Examiner’s Answer at Page 10. This argument fails because *Riseman* makes no practical distinction between the information provided by the applicant, the form accessed by the lender’s web site, and the completed loan form. Even accepting the Examiner’s definitions, however, in order to teach the limitations of the present invention, *Riseman*’s “information provided by the applicant” (which Examiner contends is the same as the present invention’s ‘loan information’) would have to be *merged* with the web form accessed via the lender’s web site (which Examiner contends is the same as the present invention’s ‘loan application form’). While claim 1 of the present invention describes the receipt of loan information previously entered by an applicant and subsequent merging of the loan information with a loan application form, *Riseman* teaches, at most, manual data entry by an applicant. The Examiner has a duty to address all words of a claim during examination. MPEP § 2143.03 (“‘All words in a claim must be considered in judging the patentability of that claim against the prior art.’ *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)”). The requirement set forth in claim 1 that the loan information and loan application form be received and merged by a web site coupled to a network cannot simply be discounted by the Examiner.

There is no suggestion that *Lebda* or *Norris* teach or suggest this limitation. Therefore, prior art does not teach “a web site coupled to the network, the web site prompting the customer to enter the loan information, receiving the loan information, and merging the loan information with a loan application form to produce a loan application[.]”

2. Riseman, Lebda and Norris, Taken Alone or in Combination, do not Teach or Suggest “Multiple Branch Terminals Configured for Receiving Loan Information at Branch Locations.”

The Examiner admits that Riseman does not explicitly teach multiple branch terminals configured for receiving loan information at lender locations. Office Action of Apr. 11, 2011, Page 3; Examiner’s Answer at Page 5. The Examiner contends, however, that “Lebda teaches the concept of multiple lenders’ terminals configured for receiving loan information at lender locations [...] (abstract, figures)[,]” and that “[t]herefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include this step as taught by Lebda for the obvious reason of making the loan information available to multiple lenders.” *Id.* The Examiner, however, does not distinguish between multiple lenders’ terminals (i.e. one Bank of America terminal and one PNC terminal) and multiple branch terminals belonging to a single lender (i.e., physically separate, but linked, terminals at two different branches of Bank of America). Of these, Lebda is clearly directed towards the former. Lebda at Fig. 7. Indeed, one of the purposes of Lebda is “...to provide a fast, convenient process to apply for credit from a large number of lending institutions[.]” Lebda, Column 1, lines 49-50 (emphasis added). The claims of the present invention, however, require multiple branch terminals configured for receiving loan information at lender locations. Accordingly, the Examiner’s proposed modification of Lebda “would render the [invention of Lebda]... unsatisfactory for its intended purpose” and thus “there is no suggestion or motivation to make the proposed modification[.]” MPEP § 2143.01(V). Appellants’ interpretation is supported by the specification of the present application. Despite the Examiner’s statements to the contrary (Office Action of Apr. 11, 2011, Page 11) (“Examiner interprets plurality of lending institutions as ‘branch locations [...]’”), one of ordinary skill in the art would understand multiple branch terminals, in light of the specification, to be part of the same larger lending institution. Indeed, the specification of the

present invention actually explains, “[a] *single bank will typically service and process loan applications from many customers in many locations (e.g., branches)*[.]” See Specification, Page 1, lines 18-19 (emphasis added). The purpose of Lebda, in contrast, is to apply for credit at numerous lending institutions. Thus, using Lebda as a reference to teach multiple terminals within a single lending institution renders Lebda unsuitable for its intended purpose. Accordingly, Lebda fails to disclose multiple branch terminals configured for receiving the loan information as required by the pending claims.

Moreover, the key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reasons why the claimed invention would have been obvious. MPEP §2143.01 (“Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so”). Thus, “[t]o reject a claim based on th[e] rationale that the Prior Art would have led one of ordinary skill in the art to combine prior art reference teachings to arrive at the claimed invention],” the Examiner must articulate, *inter alia*, a “finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings[.]” MPEP § 2143(G). Here, the Examiner only states that one of ordinary skill in the art would have combined Riseman and Lebda “for the obvious reason of making the loan information available to multiple lenders[.]” Office Action of Apr. 11, 2011, Page 3. Not only is this an inaccurate statement of the goals of the present invention, it is also simply a restatement of the Examiner’s view of what happens when the references are combined, and does not provide the required ‘teaching, suggestion, or motivation’ to combine them. Indeed, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious

unless the results would have been predictable to one of ordinary skill in the art[.]” MPEP § 2143.01(III). The Appellant respectfully contends that the Examiner has made no finding of any such teaching, suggestion, or motivation, and thus the teachings of Riseman and Lebda are not properly combinable.

For the reasons discussed above, the prior art does not teach multiple branch terminals configured for receiving loan information at lender locations.

3. Riseman, Lebda and Norris, Taken Alone or in Combination, do not Teach or Suggest Sending a Loan Application to a Credit Approval Agency.

The prior art also fails to disclose performing a credit check by sending a loan application to a credit approval agency. Riseman, at most, collects information from a credit agency, but does not send a loan application to another entity. The Examiner also asserts that Lebda’s disclosure of a “computer 100 [that] dials to the credit bureau” is the “equivalent of performing a credit check by sending a loan application to a credit approval agency[.]” Examiner’s Answer at Page 6. However, this disclosure of Lebda is also inapposite. In the system described by Lebda, the system “inputs the Fair Isaac Credit Score to the database tables 150[.]” Lebda, Col. 4, lines 24-26, which is then used by “[t]he lenders...as one determinant to the borrower’s credit risk[.]” Lebda, Col. 4, lines 39-41. However, as with Riseman, Lebda also does not disclose or teach as part of this process, sending the loan application itself to a credit approval agency, as required by, for instance, claim 1.

The Examiner further references Column 6, lines 8-45 of Norris for support, but Norris also fails to disclose this feature of the present invention. However, this section of Norris is not relevant to the claimed feature of sending the loan applicant to a credit approval agency. Instead, this section refers to internal analysis by the “neural network” once information from the credit bureau is received. Moreover, Column 4, lines 35-56 describe the credit approval process.

Significantly, *Norris does not send the loan application to the credit bureau.* Rather, Norris sends the applicant's name, address and social security number to the credit bureau. Appellant's specification on page 7, line 22 through page 8, line 6 describes the claimed process, which differs from merely sending the applicant's name to obtain a credit report. When sending the application to the credit bureau as claimed, the bureau may have a "loan decisioning calculator which determines whether the customer 88 has enough income...". See page 8, lines 1-10 of present specification. To make this determination, the bureau would need more than the applicant's name and social security number, which are the only items of information obtained by Norris before the credit bureau is consulted. See Norris, Column 5, line 60 — Column 6, line 7. Furthermore, the specification provides that the loan information (which is later merged with the loan application form to produce the loan application) may include "for example, the customer's name, address, income, social security number, desired amount of loan, loan term, monthly expenses, employment, etc. [.]". See Page 2, lines 2-5 of the present specification. The Examiner notes this difference between the prior art and the present invention, but states that "[i]n the absence of specific limitations defining what constitutes a loan application, the 'loan application' are [*sic*] given the broadest reasonable interpretation[.]" Office Action of Apr. 11, 2011, Page 9. The Appellant respectfully disagrees. "During patent examination, the pending claims must be 'given their broadest reasonable interpretation *consistent with the specification*[.]'" MPEP § 2111 (emphasis added). Therefore, the pending claims must be read in light of the specification, which in this case clearly presumes that the loan application sent to the credit approval agency will include information beyond a loan applicant's name and social security number.

In response to the Examiner's further arguments that Norris teaches sending the loan applicant to a credit approval agency through requiring a user to enter name, address, and social security number, the Appellant respectfully disagrees. Office Action of Apr. 11, 2011, Page 10. The difference between the present invention and the prior art is not, as the Examiner suggests, a difference in content, or nonfunctional descriptive material. The "real time" loan approval system described in Norris is intended to provide a faster, more convenient method of obtaining "...smaller loans, those above credit-card limits but still below a level where there might be a significant concern of the ability of the lender to repay the loan[.]" Norris, Column 1, lines 60-62. That Norris only teaches a very minimal requirement with regards to an applicant's information disclosure, therefore, accords with the purpose and teachings of Norris. However, there is a clear distinction between the transfer of basic information in Norris, and the transfer of the loan application, assembled as described in the specification and claims of the present invention. Therefore, the bare transfer of basic information from the user to the 'neural network' of Norris simply does not teach performing a credit check by sending a loan application to a credit approval agency, as contemplated in the pending claims.

Further, the Appellant respectfully disagrees with the Examiner's statement that "it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Riseman and Lebda...to include these features as taught by Norris for the obvious reason of ensuring that the applicant is credit worthy and for speedy transmittal of all related and necessary documents between the lender and the customer which are normally accomplished by traditional methods[.]" Office Action of Apr. 11, 2011, Page 4. As explained above, the key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reasons why the claimed invention would have been obvious. MPEP §2143.01 ("Obviousness can be established by

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so”). The Examiner’s reasoning focuses on why it may be generally desirable to have an efficient electronic system for running a credit check. The Appellant respectfully contends that this is not a statement showing motivation to combine or modify the prior art into a system whereby the loan processor computing system receives the loan application and automatically performs the credit check on the customer based on the loan application. Indeed, as described above, the prior art repeatedly notes the current inefficiencies and need for streamlining in the loan approval process. *See* Riseman, Column 1, lines 13-14 (“The application process for secured loans has traditionally been a protracted and inefficient process”); *see also* Lebda, Column 1, lines 34-45; *see also* Norris, Column 1, lines 47-52. Moreover, regardless of the truth of the Examiner’s statement that “...receiving a credit report...from various bureau databases...requires certain data...in formats compatible with that used by credit bureaus[,]” Examiner’s Answer at Page 12, such an assertion fails explain how the prior art teaches the claimed steps. The cited references, therefore, do not teach or suggest sending a loan application to a credit approval agency.

The Examiner also argues that the fact that Riseman’s MSS performs of all the processing steps in Riseman does not matter with regards to this claim element because “one of ordinary skill in the art would recognize the advantage of sending the application to a credit agency (another application or processor) for determining whether the customer should receive a loan based on the credit report rather than having the MSS take that decision.” Office Action of Apr. 11, 2011, Pages 8-9. However, the very purpose of the invention described in Riseman is to *reduce* the number of steps required in securing a loan: “For the applicant, the protracted nature of the process both delayed the applicant's receipt of the loan proceeds and complicated efforts to

compare the terms offered by multiple lenders. For the lender, the involvement of multiple employees with a single loan application dramatically increased the number of man hours necessary to complete a loan, thereby decreasing the lender's profit margins. Moreover, the lack of knowledge of the salesman of the lender's underwriting standards tended to result in the salesman's offer of terms unacceptable to the lender, resulting in further delays.” Riseman, Column 1, lines 38-48. Accordingly, modifying the MSS of Riseman to rely on an entity outside of the MSS itself “would render [Riseman]...unsatisfactory for its intended purpose” and thus “there is no suggestion or motivation to make th[is] proposed modification[.]” MPEP § 2143.01(V).

Therefore, the prior art references, even if combined, do not teach performing a credit check by sending a loan application to a credit approval agency.

4. Riseman, Lebda and Norris, Taken Alone or in Combination, do not Teach or Suggest a Loan Forms Database Storing Forms Used in the Creation of Loan Documents.

Riseman and Norris both fail to specifically disclose *a loan forms database storing forms used in the creation of loan documents*. The Examiner admits that “Riseman and Lebda do not teach...a loan forms database storing forms used in the creation of loan documents[.]” but then does not cite any part of Norris to cure this deficiency. Office Action of Apr. 11, 2011, Page 3. The Examiner simply argues that “closed loop” system of Norris “means that *all* the steps involved in loan processing, including the [step of completing the loan application]...can be done without human intervention (col. 2, lines 3-7)[.]” Office Action of Apr. 11, 2011, Page 11 (emphasis added). Although the process of Norris results in the output of documents (*see* Norris, claim 2), Norris fails to provide any description whatsoever as to how these documents are created. Nowhere does Norris disclose the storage of forms, or teach that the loan documents are created as part of this system. One of ordinary skill in the art would not understand Norris to

actually teach how loan forms should be created, used, and directed within the system, because Norris does not even mention in passing the creation or storage of such documents in the first instance. Therefore, with regards to a loans form database storing forms used in the creation of loan documents, Norris is not enabling prior art. MPEP § 2145 (“A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.”). The cited sections of Norris teach, at most, sending a “loan agreement” file electronically to a telephone caller, and subsequently, if “the caller has a personal computer 34, a modem 36 and a printer 37...an electronic file of the documents can be transmitted to the caller, printed out on the caller's printer 37, signed and mailed back, or sent by facsimile if available[.]” Examiner’s Answer at Page 12; Norris, Column 4, lines 56-65. Accordingly, this disclosure cannot and does not teach the complex loan information exchange of the present invention, and fails to teach in particular, a “loans forms database storing forms used in the creation o floan documents[.]” Claim 1.

Therefore, the prior art does not teach a loan forms database storing forms used in the creation of loan documents.

5. Riseman, Lebda and Norris, Taken Alone or in Combination, do not Teach or Suggest a Loan Document Creation Server Coupled to the Loan Processor Computing System and the Loan Forms Database.

Norris fails to disclose a loan document creation server coupled to the loan processor computing system and the loan forms database, wherein the loan processor computing system, upon approving the loan application, automatically forwards the loan application to the loan document creation server, the loan document creation server generating and sending the loan document to the customer, based on the loan application and the accessed loan forms in the loan forms database, the loan document creation server sending the loan document to the customer through one of e-mail, facsimile, the network and a printer coupled to a network. Although

Norris ultimately provides these documents to the customer, this step is not described as being part of the closed loop automated process of Norris. Thus, it is assumed that Norris also generates these documents using traditional methods. As set forth in the title of Norris and throughout the specification, the automated process of Norris is directed to loan approval. As discussed above, document origination is not addressed in the disclosure of Norris. Thus, Norris fails to disclose a loan document creation server that generates documents by accessing a forms database upon receiving the approved loan application from the loan processor computer system.

The Examiner's assertion that "Norris teaches if the user has a personal computer...an 'electronic file of documents' can be transmitted to the user (col.4, lines 61-63)" is immaterial to the limitations of the pending claims. Office Action of Apr. 11, 2011, Page 4. Claim 1 requires that the loan document creation server access the loan forms database and automatically generate and send the loan document to the customer, based on the loan application and the accessed loan forms in the loan forms database. Norris's disclosure of a vague electronic exchange of "documentation" (Norris, Column 4, line 57) does not teach sending a "loan document" to the customer in the manner described and claimed in the present invention. To this end, the Appellant further submits that Norris is not enabling prior art. MPEP § 2145 ("A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.").

Therefore, the prior art does not teach a loan document creation server coupled to the loan processor computing system and the loan forms database.

6. The Examiner has not Provided any Teaching, Suggestion or Motivation to Combine Riseman, Lebda and Norris.

Before considering what would be obvious to one of ordinary skill in the art at the time of the invention, the art must teach or suggest the claim limitations. *See* MPEP §2143. Thus, even

if combined, Riseman, Lebda, and Norris would not have resulted in the invention of claim 1.

“During patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability.” *In re Glaug*, 283 F.3d 1135, 62 U.S.P.Q.2d 1151, 1152 (Fed. Cir. 2002).

Accordingly, a *prima facie* case of obviousness cannot be established here. “To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int.. 1985). The references applied in the Office Action fail to suggest the claimed invention for at least the reasons herein set forth with regard to each claim.

No motivation would have existed to modify Riseman with the disclosures of Norris and Lebda. As set forth above, neither Norris nor Riseman provides a system for generating loan documents. Instead, both references disclose systems for obtaining loan approval and contain no reference to document generation. Because the two references merely disclose different processes for performing the same action (loan approval), and are not complementary in any way, no purpose would have been served by combining them. Lebda, which also fails to disclose document generation as contemplated in the present invention, discloses a process for coordinating loan qualification between multiple lending institutions. The disclosure of Lebda is therefore not relevant to the disclosures of Riseman or Norris, or to the claimed invention. While Riseman and Norris address the loan approval process, coordination between lenders is not discussed.

Thus, the combination of the teaching of Riseman, Norris, and Lebda is insufficient to establish a *prima facie* case of obviousness against claim 1 because the combination of references fails to disclose each claimed feature and because no motivation would have existed to combine the references.

D. Dependent Claims 3-5, 14 and 17-20 Are Each Separately Patentable Over Riseman, Lebda and Norris

Claims 3-5, 14 and 17-20 all depend ultimately from one of independent claim 1. As such, each of these dependent claims contains each of the elements recited in the independent claims. For the reasons stated above, Riseman, Lebda and Norris fail to teach or suggest all the elements recited in claim 1. Thus, for at least the same reasons, Riseman, Lebda and Norris cannot render claims 3-5, 14 and 17-20 obvious. To the extent that the Examiner relies on Official Notice in the rejection of claim 20, Examiner's Answer at Page 8, the Appellant challenges the assertion of Official Notice as improper and as not properly based on common knowledge, and respectfully requests the production of prior art to show that all of the features subject to Official Notice were indeed known in the art at the time of the invention, as the Appellant does not possess certain knowledge that these facts were indeed old and well known at the time of the invention. Additionally, claims 3-5, 14 and 17-20 are each separately patentable over Riseman, Lebda and Norris for the additional features that each of these dependent claims recites.

E. Independent Claim 6 is Patentable over Riseman, Lebda and Norris

Appellants submit that the combination of Riseman, Lebda and Norris does not disclose each and every element of claim 6. Similar to claim 1, claim 6 is a method claim that recites, among other things, five elements that are not taught or disclosed by the prior art: "merging, at the loan approval system computer, the loan information with the loan application form to

produce a loan application[;]” a “web site configured to receive information over the network from at least one of multiple bank branches[;]” “forwarding the loan application to a credit approval agency[;]” “a loan forms database” used to store forms; and “accessing a loan forms database from the loan document creation server[.]”

As discussed above with respect to claim 1, Riseman, Lebda and Norris fail to teach or suggest any of these limitations. For all of the reasons discussed above with regards to claim 1, claim 6 is patentable over Riseman, Lebda and Norris.

F. Dependent Claim 15 is Separately Patentable Over Riseman, Lebda and Norris

Claim 15 ultimately depends from independent claim 6. As such, this dependent claim contain each of the elements recited in independent claim 6. For the reasons stated above, Riseman, Lebda and Norris fail to teach or suggest all the elements recited in claim 6. Thus, for at least the same reasons, Riseman, Lebda and Norris cannot render claim 15 obvious. Additionally, claim 15 is separately patentable over Riseman, Lebda and Norris for the additional features that this dependent claims recites.

G. Independent Claim 7 is Patentable over Riseman, Lebda, Norris and Cohen

Appellants submit that the combination of Riseman, Lebda, Norris and Cohen does not disclose each and every element of claim 7. With regards to independent claim 7, Cohen fails to obviate the deficiencies of Riseman, Lebda and Norris noted above. Independent claim 7 defines over the art of record for at least the reasons set forth above with respect to claim 1 and additionally includes the features of analyzing the received loan information for completeness and prompting the customer if the received loan information is incomplete.

The Examiner submits that “Riseman, Lebda and Norris do not explicitly teach analyzing the received loan information for completeness and prompting the customer if the received loan

information is incomplete; sending a check to the customer, the check corresponding to the loan contract, receiving the check and cashing a check whereby cashing the check indicated acceptance by the customer of the terms listed in the loan document, checking the validity of the check[.]” Office Action of Apr. 11, 2011, Page 6. However, the Examiner contends, these claim elements are taught through a combination of Riseman and Norris (teaching electronic transfers of funds), Lebda (verification that the application is correct), and Cohen (analyzing received information for completeness and prompting the user if the received information is incomplete). Even combined, these references fail to disclose important parts of this claim element, such as: sending a check to the customer, the check corresponding to the loan contract, receiving the check and cashing a check whereby cashing the check indicates acceptance by the customer of the terms listed in the loan document.

The Examiner further takes official notice “that substituting EFT for a physical check and cashing the check to indicate acceptance by the customer of the terms listed in the loan document, checking the validity of the check and verifying the customer account by sending a test transaction are old and well known[.]” Office Action of Apr. 11, 2011, Page 7. The assertion of Official Notice has been respectfully traversed. In the present application, the Appellant has repeatedly requested production of prior art to show that all of the features subject to Official Notice were indeed known in the art at the time of the invention, as the Appellant does not possess certain knowledge that these facts were indeed old and well known at the time of the invention.

Official Notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. MPEP § 2144.03. While “official notice” may be relied on, these circumstances should be rare when an application is under final rejection. Official

Notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “capable of such instant and unquestionable demonstration as to defy dispute” (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. *See also In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979). Furthermore, courts have rejected the notion that “judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.” *In re Eynde*, 480 F.3d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973).

Furthermore, as Appellant previously challenged herein the assertions of Official Notice as improper and as not properly based on common knowledge, the Examiner was required to support the finding with adequate evidence. If the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Examiner must provide an affidavit or

declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

Therefore, with regards to claim 7, Cohen and Official Notice fail to remedy the deficiencies of Riseman, Lebda, and Norris. Withdrawal of the rejection is respectfully requested.

1. Cohen is not “analogous art” with respect to the present invention

Cohen has nothing to do with a loan approval and document origination system, or even with loan systems more generally, and is not “analogous prior art” with regards to the present invention. MPEP § 2141.01(a). Rather, Cohen is directed toward “[s]elf-administered survey devices includ[ing] a display, an input device, a memory and a control device which controls the display to show at least” *See* Cohen, Abstract. A reference in a field different from that of Appellant’s endeavor is “reasonably pertinent” if it is one which, because of the matter with which it deals, “logically would have commended itself to an inventor’s attention in considering his or her invention as a whole[.]” MPEP § 2141.01(a). There is nothing, in the Office Action or otherwise, to suggest that a reference directed completely towards self-administered surveys would logically have commended itself to an inventor of an loan document origination system’s attention in considering the loan document origination system as a whole. In fact, Cohen itself even describes its relevance as being “...particularly useful in carrying out surveys of information media experiences, such as television viewing and radio listening.” Cohen, Column 1, lines 5-7. Accordingly, this reference would not have attracted the attention of an inventor in the financial loan documents creation field. As non-analogous art, Cohen is not a proper prior art reference against the present application.

H. Dependent Claims 9-13 and 16 Are Each Separately Patentable Over Riseman, Lebda, Norris and Cohen

Claims 9-13 and 16 all depend ultimately from one of independent claim 7. As such, each of these dependent claims contains each of the elements recited in independent claim 7. For the reasons stated above, Riseman, Lebda, Norris and Cohen fail to teach or suggest all the elements recited in claim 7. Thus, for at least the same reasons, Riseman, Lebda, Norris and Cohen cannot render claims 9-13 and 16 obvious. Additionally, claims 9-13 and 16 are each separately patentable over Riseman, Lebda, Norris and Cohen for the additional features that each of these dependent claims recites.

V. CONCLUSION

For the foregoing reasons, Appellants respectfully submit that Riseman, Lebda and Norris fail to render Appellants' claims 1, 3-6, 14-15 and 17-20 obvious under 35 U.S.C. § 103(a). Appellants further submit that Riseman, Lebda, Norris and Cohen fail to render Appellants' claims 7, 9-13 and 16 obvious under 35 U.S.C. § 103(a). Accordingly, Appellants respectfully request reversal of the rejection of claims 1, 3-7 and 9-20.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-4494, and please credit any excess fees to the same deposit account.

Dated: December 16, 2011

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